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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,781	02/18/2004	De-Sheng Tsai	9286.32	2750
20792	7590	09/15/2006		
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627				
			EXAMINER COLE, ELIZABETH M	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,781

Applicant(s)

TSAI ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-28, 34-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Claims 22-28, 34-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 22 recites a product "obtained or obtainable" by a process. The scope of the claims are not clear because it is not clear if the claims are claiming a product which is made by the claimed process or which may or may not be made by the claimed product.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21, 23-25, 34-39 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09285490, (machine translation attached). JP '490 discloses an elastomeric nonwoven web comprising a bicomponent fiber which comprises polypropylene and an elastomeric component. See paragraph 0010-0014. The nonwoven can further comprise additional types of fibers including natural and synthetic fibers. See paragraphs 0025-0026. The nonwoven can be formed by melt spinning or by carding staple fibers. See paragraph 0027. The fabric can be thermally bonded. See paragraph 0028. The fabric can be incorporated into a variety of personal care articles including diapers. With regard to the particular uses set forth in dependent claims 34-39, since no structure is set forth in the claims, these limitations are taken as statements of intended use.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-25,34-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 09285490. JP '490 discloses an elastomeric nonwoven web comprising a bicomponent fiber which comprises polypropylene and an elastomeric component. See paragraph 0010-0014. The nonwoven can further comprise additional types of fibers including natural and synthetic fibers. See paragraphs 0025-0026. The nonwoven can be formed by melt spinning or by carding staple fibers. See paragraph 0027. The fabric can be thermally bonded. See paragraph 0028. The fabric can be incorporated into a variety of personal care articles including diapers. With regard to the particular uses set forth in dependent claims 34-39, since no structure is set forth in the claims, these limitations are taken as statements of intended use. JP '490 does not disclose the particular elongation and recovery set forth in claims 22 and 23. However, since JP '490 teaches the same structure, it is reasonable to presume that the material of JP '490 would necessarily have the same properties. With regard to the process limitations set forth in claims 22 and 23, it is noted that product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product - by process claims are limited by and defined by the process, determination of patentability

is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe , 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

The use of 35 USC 102/103 rejections for product by process claim has been approved by the courts. "[T]he lack of physical description in a product - by - process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product - by - process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown , 173 USPQ 685, 688 (CCPA 1972).

Further, with regard to the process limitations it is noted that JP '490 teaches heating and drawing the nonwoven web at paragraph 0022 to increase the flexibility of the web. The burden is on the applicant to show that any process differences result in an unobvious difference between the claimed product and the product of JP '490.

Finally, with regard to the process limitations, it is not clear whether the claims require the particular process limitation or not, since the claim recites "obtained or obtainable" by the process. If the particular process is not a requirement of the claim but is an option, then JP '490 anticipates the claimed invention.

5. Claim 22-23, 26-28, 35-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Erdos et al, U.S. Patent Application Publication 2002/0056510. Erdos et al discloses an elastic nonwoven fabric laminate. The nonwoven fabric can comprise polypropylene fibers, and may be spunbonded, or a thermally bonded carded nonwoven of staple fibers. See paragraph 0050 and claim 4. The fabric is bonded to an elastic film layer. The laminate is subjected to heat, pressure and tension in order to form the elastic fabric. The elastic fabric laminate has good CD elongation and recovery, with a CD elongation of at least 120% and recovery of at least 80% after elongation of 100%. See paragraph 0017, 0024, 0049, The fabric can be incorporated into a variety of personal care articles including diapers. With regard to the particular uses set forth in dependent claims 34-39, since no structure is set forth in the claims, these limitations are taken as statements of intended use. See paragraph 0058-0060.

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6. Erdos et al does not identically disclose the claimed processing parameters. However, as set forth above, product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Therefore, the burden is on Applicant to show that the processing differences result in an unobvious difference between the claimed invention and the invention of Erdos et al. Further, it is noted that Erdos teaches drawing the nonwoven after it is thermally calendered. Finally, with regard to the process limitations, it is not clear whether the claims require the particular process limitation or not, since the claim recites "obtained or obtainable" by the process. If the particular process is not a requirement of the claim but is an option, then JP '490 anticipates the claimed invention.

7. Claims 22-28, 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdos et al, U.S. Patent Application Publication 2002/0056510 in view of JP 09285490. Erdos et al discloses an elastic fabric laminate as set forth above. Erdos et al differs from the claimed invention because it does not teach employing conjugate fibers in the nonwoven. JP '490 teaches that bicomponent fibers can be employed in forming elastic nonwovens comprising polypropylene. Bicomponent fibers are generally used to facilitate bonding due to the different melting points between the sheath and core. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed bicomponent fibers in the nonwoven of Erdos, motivated by the teaching of JP '490 that such fibers were useful in forming elastic nonwovens and by the expectation that the use of bicomponent fibers would facilitate bonding within the nonwoven while maintaining the strength of the fabric.

8. Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive. Applicant argues that the process set forth produces a different product than the products of JP '490 and Erdos. However, as set forth above, JP '490 teaches a fabric which can be carded which would necessarily align the fibers. JP '490 teaches heating and drawing after fabric formation to increase flexibility. Similarly, Erdos teaches a fabric having the same structure and having the same or similar stretch and recovery. In order to show that the process differences result in an unobvious difference Applicant must present evidence to show that this is the case. In the instant case, Applicant states that the fabrics of Erdos and JP '490 would not have the properties because they are not made by the same process. However, the claims themselves do not appear to require that the process be used to make the laminate. Further, stating that the Erdos fabric would not have the same properties is not sufficient to show that it would not. Applicant argues that the particular process steps impart a particular structure to the fabric. However, Applicant has not shown that the fabrics of JP '490 or Erdos would not have the same structure, i.e., enhanced stretch and recovery or fiber orientation. With regard to the fiber orientation, Applicant argues that the drawing step aligns the fibers. However, with regard to a spunbonded nonwoven, the fibers are randomly disposed and the fabric is bonded. Drawing will not fully align the fibers in a particular direction. Further, it is noted that carding fibers as taught by both Erdos and JP '490 necessarily aligns fibers. Therefore, both Erdos and JP '490 teach aligned fibers even if they do not teach the same method of aligning the fibers. Similarly, with regard to the claimed process, Applicant asserts that because of drawing

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and cooling the fibers have recovery after stretching. However, both Erdos and JP '490 teach elastic materials which recover after stretching. No comparison has been made between the prior art products and the instantly claimed products. Additionally, both Erdos and JP '490 teach additional drawing steps which can be performed in order to further enhance the flexibility and stretch of the fabrics. See paragraph 0022 of JP '490 and paragraph 0046 of Erdos. Therefore, the rejection has been maintained.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571)


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272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.


Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c